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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/282,764	03/31/1999	JAY PONTE	99-808	9068
32127 7590 10/08/2009 VERIZON LEGAL DEPARTMENT PATENT MANAGEMENT GROUP 1320 N. COURTHOUSE ROAD 9TH FLOOR ARLINGTON, VA 22201-2525			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3688	PAPER NUMBER
			NOTIFICATION DATE 10/08/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary****Application No.**

09/282,764

**Applicant(s)**

PONTE ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

3688

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8, 10-12, 14-17, 19-21, 23, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8, 10-12, 14-17, 19-21, 23, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Prosecution Re-opened***

1. A review found that the claims filed after final on 26 September 2005 failed to comply with 35 USC § 101. The indication of allowable matter made of record on 10 October 2005 is hereby withdrawn and a new non-final rejection follows. The claims could be put into condition for allowance by approval of the proposed examiner's amendment given below.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 6-8, 10-12, 14 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, 3d Cir., 2008 WL4757.
4. The claims are tied to a machine or apparatus, a "computer system", but this limitation appears only in a preamble, which is not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). This rejection can be

Art Unit: 3688

overcome by explicitly claiming that at least one significant step is performed with a computer system. One acceptable option is offered below.

5. Claims 15-17, 19-21, 23 and 27 are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted to be a computer program, does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). Computer programs are nonstatutory functional descriptive material (MPEP § 2106.01.I, last para.). This rejection can be overcome by claiming a computer readable medium having machine executable code thereon for executing a method. One acceptable option is offered below.

***Allowable Subject Matter***

6. Claims 6-8, 10-12, 14-17, 19-21, 23, 26 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action. An amendment that would do that is proposed at para. 9-13 below.
7. The following is an examiner's statement of reasons for allowance over the prior art: the closest prior art, Herz et al. in view of Kramer et al., does not teach or suggest that the documents in said at least one category include business information taken from listings in at least one directory of businesses. This applies to all independent claims 6, 15, 26 and 27. That is, these references neither teach nor suggest their use as an online business directory. The closest non-patent prior art, *GTE Superpages*, teaches an online business directory, but the prior art neither teaches nor suggests adding the teachings of *GTE Superpages* to those of Herz et al. and Kramer et al.
8. The claimed invention defines an online business directory (online "yellow pages"). Together Herz et al. and Kramer et al. teach or suggest every aspect of the claimed invention except its application as an online business directory. *GTE Superpages* not only teaches an online business directory, but it describes applicant's early version of the claimed invention. Yet there is nothing in the prior art to suggest that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of *GTE Superpages* to those of Herz et al. and Kramer et al. That is, one of ordinary skill in the art, at the time of the invention, would not have found it obvious to implement the

Art Unit: 3688

combination of Herz et al. and Kramer et al. as a yellow-pages-style online business directory.

***Suggested Examiner's Amendment***

9. Claims 6 and 14 would be allowable if any one or more of the following four, clearly significant limitations of independent claim 6 were amended as follows:

"using the computer system to associate ~~associating~~ at least one supercategory with multiple categories including said at least one category by mapping the multiple categories to the at least one supercategory;

using the computer system to associate ~~associating~~ an advertisement with at least one of said supercategories, the advertisement being separate from the documents contained in the at least one category;

using the computer system to determine ~~determining~~ at least one term associated with a user search query;

using the computer system to determine ~~determining~~ a first of said at least one supercategory based on at least one term of said user search query and said multiple categories of the at least one supercategory;"

10. Claims 7, 8, 10-12 and 26 would be allowable if any one or more of the following four, clearly significant limitations of independent claim 26 were amended as follows:

"using the computer system to associate ~~associating~~ at least one supercategory with multiple categories including said at least one category by mapping the multiple categories to the at least one supercategory;

using the computer system to associate ~~associating~~ an advertisement with at least one of said supercategories, the advertisement being separate from the documents contained in the at least one category;

using the computer system to determine ~~determining~~ at least one term associated with a user search query;

Art Unit: 3688

using the computer system to determine determining a first of said at least one supercategory based on at least one term of said user search query and said multiple categories of the at least one supercategory; and".

11. The examiner will consider alternate language that satisfies the requirements for method/process claims elucidated by the courts in *Bilski* and previous cases: The claim must have at least one "meaningful" or "significant" limitation that is "tied to" a particular machine or apparatus (para. 2-4 above). Language only in the preamble is not meaningful. The examiner also believes that all input/output steps are also not meaningful or significant in this context.

12. Claims 15-17, 19-21, 23 and 27 would be allowable if the preamble of each independent claim 15 and 27 was amended as follows:

"15. A ~~computer program product~~ tangible computer readable medium for displaying advertisements on a computer system comprising:" and

"27. A ~~computer program product~~ tangible computer readable medium for displaying advertisements comprising:".

13. It is noted for the record that the instant application does not explicitly disclose a "tangible computer readable medium" but such a component is implicit, and indeed inherent, to the "computer system" that is disclosed. The examiner will consider alternate language.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

15. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.

Art Unit: 3688

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2 October 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688